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## PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

555255-012611

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on May 28, 2009

Signature Debra PejeauTyped or printed name Debra Pejeau

Application Number

10695137

Filed

10/28/2003

First Named Inventor

Larry E. Hawker

Art Unit

2614

Examiner

Disler Paul

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

Joseph M. Sauer/☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.  
(Form PTO/SB/98)Joseph M. Sauer

Signature

Typed or printed name

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attorney or agent of record.

Registration number 47,919216-586-7506

Telephone number

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attorney or agent acting under 37 CFR 1.34.

Registration number if acting under

May 28, 2009

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.  
Submit multiple forms if more than one signature is required, see below.☐

\*Total of \_\_\_\_\_ forms are submitted.

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant : Hawker, et al.  
Title : SYSTEM AND METHOD OF ACOUSTICALLY SAFE  
AUTOMATIC HANDSFREE VOLUME ADJUSTMENT  
Application No. : 10/695,137  
Filed : October 28, 2003  
Group Art Unit : 2614  
Examiner : Disler Paul

**REQUEST FOR PRE-APPEAL BRIEF CONFERENCE**

Dear Sirs:

The Examiner has issued a Final Rejection of the pending claims. The Applicant hereby requests review of the Final Rejection prior to filing an appeal brief for the reasons set forth below. Any fees due should be charged to Jones Day Deposit Account No. 501432, ref: 555255-012611.

## **ARGUMENT**

The Final Office Action issued on February 2, 2009 rejects each of the pending claims under 35 U.S.C. § 103(a). The Applicant respectfully submits that these rejections demonstrate clear error and must be withdrawn. Without waiving the right to argue other issues, the Applicant will show that the rejections are clearly erroneous in at least two independent respects: (1) the Examiner applied an incorrect legal standard, and (2) the Examiner failed to produce evidence of all elements of the claimed subject matter.

### **I. The Examiner Applied an Incorrect Legal Standard.**

Independent claims 25 and 33 recite a “safe volume profile providing a default volume setting...selected to reduce the risk of damage to a user’s hearing if [the mobile device or a speaker] is operated in close proximity to the user’s ear while in the handsfree mode of operation.” Among other distinctions, the cited references (particularly the Kraft reference (U.S. 2002/0107009)) fail to disclose or suggest any such element.

The Examiner does not dispute that a claim element is missing from the cited references. Instead, the Examiner concludes that the default volume settings disclosed in the Kraft reference (U.S. 2002/0107009) would inherently reduce the risk of damage to the user’s hearing. The Applicant submits that the Examiner’s reliance on the doctrine of inherency to show this claim element is clearly in error and thus cannot support a rejection under 35 U.S.C. § 103.

To support a conclusion of inherency, the Examiner must prove *necessity*. If the element is not necessarily present in the cited reference, then that element is not inherent. *See MEHL/Biophile Int’l. Corp. v. Milgram*, 192 F.3d 1362, 1365, 52 USPQ2d 1303, 1305 (Fed. Cir. 1999). The MPEP is clear on the limitations of the doctrine of inherency, stating that there must be facts or technical reasoning that supports “the determination that the allegedly inherent

characteristic *necessarily flows* from the teachings of the applied prior art.” MPEP § 2112(IV) (emphasis added).

Here, there is not only a complete lack of facts supporting the Examiner’s conclusion of inherency (that is, the Examiner has provided no evidence to satisfy the Examiner’s burden of proving—as opposed to merely asserting—inherency), but the Kraft reference itself teaches the *opposite* of the allegedly inherent subject matter. In other words, the Examiner’s own reference actually shows that the element is not necessary at all.

The Kraft reference describes a “hands free” setting on a telephone that may be used when operating the phone in a “driving” mode. Paragraph [0032] of Kraft discloses the function of detecting when the telephone has been placed in a car kit holder in order to cause the telephone to automatically answer an incoming call without the driver having to remove his or her hands from the wheel. With respect to the volume settings, Table 2 of the Kraft reference indicates that the phone should be operated at *the highest* volume setting of “level 5” when in the “driving” mode, which as noted above, is Kraft’s handsfree mode of operation. (By cross-referencing Tables 1 and 2 of the Kraft reference, it is seen that column number 5 of Table 2 identifies the settings for the “ringing volume,” which is indicated to be at “level 5” for the “driving” mode. As shown in Table 1, “level 5” is the highest setting for the “ringing volume” function.)

Therefore, Kraft discloses that the *highest* volume setting should be used in the handsfree mode, not a lower, safer volume setting that would be less susceptible to damaging the user’s hearing.

Because the Kraft reference expressly teaches using the highest possible volume setting when its telephone is in handsfree mode, it cannot reasonably be concluded that the claimed

“safe volume profile” *necessarily* flows from the teachings of this reference. If anything, the reference would lead a person skilled in the art away from this claim element.

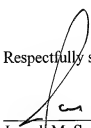
Accordingly, the Examiner’s inherency findings are clearly not supportable, and the rejections under 35 U.S.C. § 103 must be withdrawn.

## **II. The Cited References Failed to Disclose All Elements.**

To make a prima facie case under section 103, the Examiner’s burden includes (but is not limited to) citing references that teach or suggest all of the features of a claimed invention. *E.g., In re Ochiai*, 71 F.3d 1565, 1572 (Fed. Cir. 1995). If the references fail to teach or suggest one or more elements, the Examiner’s prima facie case is flawed for failing to meet this legal standard.

As noted above, the Examiner has effectively conceded that the cited references do not disclose all elements of the claims. The failure of the Examiner to produce evidence of all elements is decisive on the issue of the validity of all of the pending rejections. The rejections are not supportable under 35 U.S.C. § 103, and must be withdrawn.

Respectfully submitted,



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